

U.S. Patent Application Serial No. 10/721,069
Response filed June 16, 2005
Reply to OA dated February 22, 2005

REMARKS

Claims 1-3, 5 and 6 are pending in this application. Claims 4 and 7-22 have been canceled without prejudice or disclaimer, and claim 1 has been amended in order to more particularly point out, and distinctly claim the subject matter to which Applicant regards as the invention. Applicant respectfully submits that no new matter has been added. It is believed that this Amendment is fully responsive to the Office Action dated **February 22, 2005**.

Restriction is required to one of the following inventions: I. Claims 1-6 and 20-22; II. Claims 7-16; III. Claims 17-19. (Office action paragraphs no. 2-4)

Applicant here affirms the election of Group I (claims 1-6 and 20-22). Non-elected claims 7-16 and 17-19 have been canceled without prejudice or disclaimer.

The disclosure is objected to because of informalities. (Office action paragraph no. 5)

The objection is overcome, as follows:

(1) The Examiner refers to JIS K 6301 on page 18 (paragraph [0045]), noting that the specification does not give the details for this standard. The Examiner indicates that this objection is relevant to the description and enablement of the matter of claim 20. Claim 20 has been canceled without prejudice or disclaimer.

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(2) The Examiner notes that “rebound resilience” is not explicitly defined. The Examiner indicates that this objection is relevant to the description and enablement of the matter of claim 21. Claim 21 has been canceled without prejudice or disclaimer.

3) The Examiner notes that trademarks should be presented in all capitals. Applicant has amended the specification to place all trademarks in all-capitals.

Claims 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which applicant regards as the invention. (Office action paragraph no. 8)

The rejection is moot in view of the cancellation of claims 20 and 21 without prejudice or disclaimer.

Claims 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. (Office action paragraph no. 10)

The rejection is moot in view of the cancellation of claims 20 and 21 without prejudice or disclaimer.

Claims 20-22 are objected to under 37 CFR 1.75(c) as being of improper dependent form. (Office action paragraph no. 11)

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The objection is moot in view of the cancellation of claims 20-22 without prejudice or disclaimer.

Claims 1-3 and 20-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 2001/0033982A1 (Ishikawa). (Office action paragraph no. 14)

The rejection of claims 20-22 is moot in view of the cancellation of these claims without prejudice or disclaimer.

The rejection of claims 1-3 is overcome by the amendment to claim 1. Claim 1 has been amended to add the limitation: "the average number of particles of the external additive, having a volume average primary particle diameter in the range of 0.1-3.0 μm , on the surface of the colored polymer particle, is in the range of 3-500 particles per single colored polymer particle." Support for this amendment may be found in paragraph [0035], on page 14 of the specification.

Ishikawa et al. '982A1 discloses a toner:

"comprising at least primary polymer particles and primary colorant particles, and at least one layer of a particulate resin coated on a substantial surface portion of said agglomerate of particles, wherein at least one of said primary polymer particles and said particulate resin further comprises a wax, and wherein an outermost layer of said particulate resin is substantially free of wax." (Ishikawa, claim 1)

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However, Ishikawa et al. neither discloses nor suggests the particles of the external additive having a volume average primary particle diameter in the range of 0.1-3.0 μm , nor the number of particles of the external additive, as recited in amended claim 1.

Moreover, Ishikawa et al. determined the charged amount of the toner by the blow-off method (see [0184] and [0185]). More specifically, Ishikawa et al. mixed the toner with carrier to charge the toner by attrition, and determined the charge amount of the toner. In the present specification, Applicant determines the charge amount of the toner by vacuum method (see [0069] of the present specification). Although the charged amount of the toner is different depending on the kind of the carrier used in blow-off method, the charged amount of the toner itself is determined in the present invention.

Claims 1-3, 6 and 20-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 00/58790 (Masuo), as evidenced by applicant's admissions on page 7, line 27, page 9, lines 23-26, and page 10, lines 7-8, of the instant specification. (Office action paragraph no. 15)

The rejection is moot for claims 20-22, which are canceled without prejudice or disclaimer.

The rejection of pending claims 1-3 and 6 is overcome by the amendment to claim 1. As discussed above, the amendment to claim 1 limits the average number of particles of the external additive and their volume average particle diameter.

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The toner described in Masuo et al. comprises particles different in average particle diameter as external additive.

“When the external additives are used in combination, it is preferable to use two kinds of inorganic oxide particles different in average particle diameter from each other and a metal oxide in combination. For example, when two kinds of silica having a great particle diameter and a small particle diameter, and conductive titanium oxide are used in combination, a filming preventing effect can be achieved. As examples of a combination of inorganic oxide particles different in average particle diameter, may be mentioned a combination of particles having an average particle diameter of **5 to 20 nm**, preferably 7 to 18 nm and particles having an average particle diameter of greater than 20 nm, preferably **30 nm to 1 μ m**.” (Masuo ‘535, column 19, lines 24-36, emphasis added)

Masuo et al. neither discloses nor suggests particles of the external additive having a volume average primary particle diameter in the range of 0.1-3.0 μ m, nor the number of particles of the external additive, as recited in amended claim 1.

Claims 1-3, 6 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuo, as evidenced by applicant’s admission at page 7, line 27, combined with U.S. 6,096,468 (Ohno). (Office action paragraph no. 16)

The rejection is moot for claims 20-22, which are canceled without prejudice or disclaimer.

The rejection of pending claims 1-3 and 6 is overcome by the amendment to claim 1. As discussed above, the amendment to claim 1 limits the average number of particles of the external additive and their volume average particle diameter.

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Ohno et al. uses hydrophobic fine silica powder as an additive. However, Ohno et al. neither discloses nor suggests the particles of the external additive having a volume average primary particle diameter in the range of $0.1\ \mu\text{m}$ - $3.0\ \mu\text{m}$, nor the number of particles the external additive, as recited in amended claim 1.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masuo, as evidenced by applicant's admissions on page 7, line 27, page 9, lines 23-26, and page 10, lines 7-8, of the instant specification, combined with US 6,074,794 (Fushimi). (Office action paragraph no. 17)

The rejection is overcome by the amendment to claim 1.

Fushimi et al. uses hydrophobic silica as additives. However, Fushimi et al. neither discloses nor suggests the particles of the external additive having a volume average primary particle diameter in the range of 0.1 - $3.0\ \mu\text{m}$, and number of particles the external additive.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masuo, as evidenced by applicant's admissions on page 7, line 27, combined with Ohno as applied to claim 1, and further combined with US 6,074,794 (Fushimi). (Office action paragraph no. 18)

The rejection is overcome by the amendment to claim 1.

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As noted above, Masuo et al., Ohno and Fushimi do not disclose or suggests the particles of the external additive having a volume average primary particle diameter in the range of 0.1 μm -3.0 μm , or the number of particles the external additive, as recited in amended claim 1.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa combined with Japanese Patent 2000-221726 (JP '726). (Office action paragraph no. 19)

The rejection of claim 4 is moot in view of the cancellation of claim 4 without prejudice or disclaimer.

Reconsideration of the rejections is therefore respectfully requested.

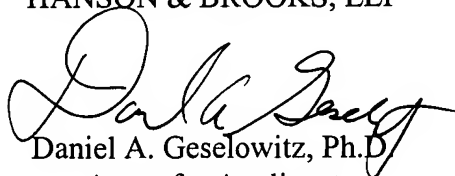
If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

Enclosure: Petition for Extension of Time (1 month).

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